

REMARKS

Applicant expresses appreciation to the Examiners for the personal interview granted to applicant's representative. As proposed at the interview, independent method claims 1 and 42 have been amended as discussed. Corresponding independent claims 24 and 52 are also presented. Dependent claims 2 – 10 and 43, 45 – 51 depend from the remaining independent claims. All other claims have been cancelled without prejudice. Thus, by this paper claims 1 – 10, 24, 42, 43 and 45 – 52 are presented for reconsideration.

In the Office Action Fig. 5 of the drawings were objected to as containing an incorrect reference numeral. The drawing has been corrected, and a red-line copy showing the correction is attached at Appendix A, as well as a new formal drawing sheet, which is enclosed.

The disclosure was objected to because of certain minor grammatical or other errors, each of which has been corrected as noted above. Entry of the amendments making these corrections is respectfully requested.

Claims 24 – 41, directed to a computer program product, were rejected under 35 U.S.C. § 101 as non-statutory because of the disclosed computer readable media described in the specification is disclosed as encompassing wireless signals. The Office Action asserts that “wireless signals are not tangible, and cannot tangibly embody a computer program or process since a computer cannot understand/realize (i.e. execute) the computer program or process when embodied on the data signal.” Office Action at ¶ 4, pp. 3 – 4.

As noted at the interview, the claims presented herein to the claimed computer program product (e.g., independent claims 24 and 52) claims “a tangible computer readable media for

providing storage within the computer system of computer executable instructions that implement.” As discussed, this overcomes the asserted ground for rejection.¹

Lastly, the Office Action also rejected all of the claims as either anticipated under 35 U.S.C. § 102(e) by U. S. Pat. No. 6,721,767 B2 (De Meno et al.) or under 35 U.S.C. § 103(a) as obvious over De Meno et al. in combination with certain teachings from U. S. Pat. No. 6,449,624 B1 (Hammack et al.).²

As noted at the interview, De Meno et al. does not address or solve the problem solved by applicant’s claimed method and computer program product. De Meno et al. discloses an application specific rollback “module with an index for assisting in locating different stats of the application specific *data* that were generated by the user requests. Also included . . . is a logical view storage that provides an organizational scheme for storage of the application specific data on one of a plurality of storage media, for migration of the . . . *data* to other ones of the plurality

¹ However, applicants reserve the right to further challenge this ground of rejection by way of presenting corresponding claims which define the computer readable medium in terms consistent with the breadth of that term as provided in applicants’ specification in any related application, as deemed appropriate by applicants. There are sound policy reasons why a signal or carrier wave used to provide software to users should be treated no differently for purposes of patent eligibility than a computer disc such a CD or floppy disk. On a strictly factual basis it is highly questionable whether a signal or carrier wave is not “tangible” in any event. Simply because one cannot see or touch the medium does not change the reality that such a medium nonetheless is real and is used every day to transmit and download software just as effectively as software contained on a CD. Thus, to deny patent eligibility for such claims is to ignore the reality that such media is most certainly employed in the using and selling of software carried by such a medium, and thus denies claims to a patent owner that would otherwise provide a basis for asserting direct infringement against competitors, thereby relegating such subject matter to assertions of indirect infringement only, with no sound policy basis for doing so. To deny such computer program products of patent protection on this basis appears to be exalting form over substance. Moreover, asserted reason for treating so-called “signal” claims differently from other kinds of computer readable media (e.g., that “wireless signals are not tangible, and cannot tangibly embody a computer program or process since a computer cannot understand/realize (i.e. execute) the computer program or process when embodied on the data signal.” Office Action at ¶ 4, pp. 3 – 4) is equally as true for other media such as disks or CDs. Executable instructions on a disk or CD, like those carried by a signal, also cannot be understood or executed until those computer-executable instructions are off-loaded from the disk or CD into the computer’s RAM. This is no different for a carrier signal, and hence the asserted factual distinction as to tangibility simply lacks merit.

² Since De Meno et al. qualifies as “prior” art, if at all, under 35 U.S.C. 102(e), and Hammack et al. qualifies, if at all, under 35 U.S.C. 102(a), applicant reserves the right to challenge the status of either reference as qualifying “prior” art. Accordingly, any statement or comment herein to either reference is made merely for purposes of argument, and assumes *arguendo* that such references are proper qualifying prior art.

of storage media, for tracking the migration of the . . . *data* over time, and for maintaining the index” Abstract.

De Meno et al. does not anticipate or make obvious, either singly or in combination with Hammack et al.³ or any other reference of record, applicant’s claimed method and computer program product. As noted at the interview, although many software applications provide undo/redo functionality for the *data* on which the application operates, (*e.g.*, the undo/redo edit for text in a standard text editor), no such functionality currently exists for software configuration settings. Further, once a software application is closed, any record of the configuration settings that existed prior to the change no longer persist. This results in making a user feel leery about experimenting with configuration settings. For example, when a user is presented with a dialog box with options for changing configuration settings that they don’t understand very well, he/she doesn’t feel confident in making a selection. Accordingly, the user is less likely to experiment with the options, and may not be getting the optimum performance from the application.

Applicant’s invention solves this problem. As claimed for example in the claims 1 and 42 (directed to a method) and 24 and 52 (directed to a computer program product for the method), applicant has defined a method of reverting a current configuration setting for a software application to a previous configuration setting so that the software application will be capable of operating on data in the same manner as it did with the previous configuration settings that were used by the application software. Based upon a request from a user or a selection from

³ De Meno et al. was conceded in the Office Action as failing to teach using XML format for storing header and application payload portions to track changes. Hammack et al. was cited merely as teaching the use of XML data to changes made by an operator controlling an industrial process control system used in the manufacture, for example, of pharmaceuticals when following a “recipe” using such steps “filling a reactor vessel . . . with appropriate materials, mixing the materials within the reactor vessel, heating the materials within the reactor vessel to a certain temperature for a certain amount of time, emptying the reactor vessel and then cleaning the reactor vessel to prepare for the next batch run.” Col. 4. lines 33 – 39.

the software application,⁴ the method first requires generating changes to the software application's configuration settings. A configuration store is then updated by storing therein the changed application configuration settings of the software application to maintain a history of one or more configuration setting changes for the software application. Next, a package is generated "that uniquely identifies the contents of the package and the changes to the software application's configuration settings so that the package can be later recalled and used when reverting the configuration settings of the software application back to a state that existed prior to the changes in the configuration settings." Claims 1, 24, 42 and 52. The package is then stored "in a software application configuration log, from which it is later retrieved when it is desired to revert the configuration settings of the software application back to a state that existed prior to the changes in the configuration settings so that the software application will be capable of operating on data in the same manner as it did with the previous configuration settings that were used by the application software." *Id.* Finally, the contents of the package are used to "revert the configuration settings back to those that existed prior to the changes identified by the package so the software application will thereafter be capable of operating on data in the same manner as it did prior to such changes." *Id.*

Clearly, and as noted in the Interview Summary, De Meno et al.'s "rollback module refers to data not software applications, as contrasted to applicant's proposed amendment which [is] directed to specifically generating a package that uniquely identifies the changes to the software application." Thus, as concluded in the Interview Summary, subject to updating the search, the proposed amendment "appears to advance the claims over the current [art] of record

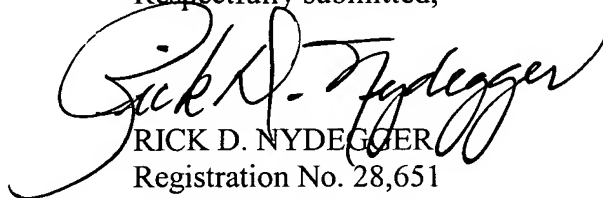
⁴ As distinguished, for example, in the case where a software developer is writing code in the first instance, this invention requires a request from an end user, or from the software application itself at run time.

...” Accordingly, for at least the reasons noted, the claims are patentable over the prior art of record, and favorable reconsideration is therefore respectfully requested.

In the event the Examiner finds any remaining impediment to allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 16th day of February, 2006.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Rick D. Nydegger", is written over the typed name and registration information.

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AMENDMENTS TO THE DRAWINGS

Please amend the drawings related to the present application. Specifically, please amend Figure 5 to include minor changes. For the Examiner's convenience, replacement drawing sheets are included herewith showing the minor changes. In addition, annotated copies of the original drawing sheets are also included showing the changes made in red ink. These sheets are attached hereto as Appendix A.

